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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771.692	01/30/2001	Madoka Mitsuoka	1405.1035 (JDH)	8152

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,692

Applicant(s)

MITSUOKA ET AL.

Examiner

James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on September 27, 2005 has been considered but is ineffective to overcome the Govindarajan et al (6,208,659) reference. The amendment added new Claims 18 and 19 and amended Claims 1 and 12-17. Therefore, the currently pending claims considered below are Claims 1-19.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Govindarajan et al (6,208,659).

Claims 1, 3, and 12-19: Govindarajan discloses a method, program, and apparatus for using status symbols (icons), comprising:

- a. storing a user status-setting symbol (icon) (Figure 6A, item 610 and col 11, lines 20-25);
- b. selecting by a first user a status icon to use as a self-status designation (Figure 6A, item 610 and col 11, lines 20-25);

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c. distributing over the network to a second user the status icon representing the first user's status (Figure 6B, item 620; col 11, lines 48-61; and col 12, lines 34-37); and selecting the status icon by the second user to use as a self-status designation (col 11, lines 20-25).

While Govindarajan discloses that the status icon may represent a business, such as one employing the user and that the user may select, alter, and update the icon, Govindarajan does not explicitly discuss that such a status symbol (status icon) would remind a person of the items or services of that business. However, an icon which represents a business is an advertisement for that business in that it is used to remind a person of not only the business (advertiser) itself, but also of the items or services provided by the business – much like two golden arches in the shape of an M not only reminds the person of the McDonalds™ company but also of the types of fast food offered by the company. Furthermore, these claims do not include any functionality pertaining to the ownership of the symbol; thus, little, if any, patentable weight is given to what or whom the icon represents. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the status symbol selected by the first user could represent any type of entity or non-entity to include an advertiser or business. For example, the symbol to represent that the first user is traveling could be a generic drawing of a car or it could be a picture of a Ford Mustang (representing the Ford Motor Company, i.e. an advertiser). Either type of symbol could be used to denote the status of the first user in Govindarajan without altering the above claimed steps.

While Govindarajan does not explicitly disclose that the second user also requests to use (selects) the status symbol to represent his status, it would have been obvious that any user connected to the system could select one of the store symbols as a self-status designation symbol. If the second user liked the symbol displayed as a status symbol of the first user, he would have been motivated to select the status-symbol to also represent his status.

Claim 2: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, and further discloses the first user requesting the use of the symbol through a web page (col 4, lines 54-57). While it is not explicitly disclosed that the webpage is provided by an advertiser, the owner of the webpage in the claim is only accepting the request from the first user to use the symbol and is not providing any advertising to the first user. Thus, little if any patentable weight is given to the ownership of the webpage at which the symbols are stored. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that any entity, including an advertiser, could be providing the webpage with the stored symbols from which the first user selects his desired status symbol. One would have been motivated to have an advertiser provide the webpage in order to have financial backing for the whole system (through the advertiser's advertising budget).

Claim 4: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, but does not explicitly disclose charging any of the entities for using the symbol. Official Notice is taken that it is old and well known within the economic arts to place a value on an icon representing a business or other entity and to either charge or pay another entity for displaying (using) the icon. For example, franchisees usually pay the franchiser for the privilege of displaying the franchiser's symbol on the franchisee's place of business, business cards, advertisements, etc. Likewise, businesses pay other entities to display their symbol/logo/icon, such as a sporting goods company paying a professional athlete to wearing clothing prominently displaying the company's logo or name. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for the entities in Govindarajan to either pay or receive payment for using the symbol. One would have been motivated to include such payments in Govindarajan in order to make the system financially viable.

Claim 5: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, but does not explicitly disclose the owner of the icon providing privileges when the first user selects the symbol as his status-symbol. However, this claim is broad enough that the claimed "privileges" would encompass the first user receiving payment for using the symbol as discussed in the rejection of Claim 4 above.

Therefore, it would have been obvious to inform the first user of such privileges upon the selection of the symbol by the first user. One would have been motivated to inform the user of such privileges in order to possibly influence his choice of symbols from the

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stored symbols database (e.g. the user would be more likely to choose a symbol which pays him over a symbol which charges him for its use).

Claim 6: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, and further discloses the system (awareness device) setting the status symbol based on changes to the first user's status (col 14, lines 56-63 and col 16, lines 34-41).

Claims 7 and 8: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, but does not explicitly disclose that the advertiser is charged a fee based on the number of referrals (click-throughs) for the symbol selected by the first user nor that the first user receives an incentive (such as a coupon) also based on the number of referrals. However, Official Notice is taken that it is old and well known within the advertising arts to charge an advertiser based on the number of exposures their advertisement has received, such as the number of click-throughs a banner advertisement receives on a webpage. It is also well known to provide incentives which vary using the same criteria to the owner of that same webpage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to bill the advertiser and to provide incentives to the first user based on the number of "referrals" counted during a time period. One would have been motivated to base the bill and incentive on the number of referrals in order to maintain the equitability and fairness of the system to both the advertiser and the user.

Claims 9-11: Govindarajan discloses a method for using status symbols (icons) as in Claim 1 above, and further discloses the system (awareness device) setting the status symbol based on changes to the first user's status (col 14, lines 56-63 and col 16, lines 34-41). While it is not explicitly disclosed that the user's status is changed when the user visits or makes a purchase at a retail outlet or when content is accessed online, these would all be encompassed the disclosure that the system changes the status symbol of the user when the user's status changes. The Govindarajan system does not react differently based on where the user's status information is coming from. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to change the status symbol in Govindarajan when the user visits or makes a purchase at a retail outlet, accesses content online, arrives at the office, goes to lunch, etc. One would have been motivated to apply these changes to the status symbol in order to keep the current status of the user up-to-date.

Response to Arguments

4. Applicant's arguments filed September 27, 2005 have been fully considered but they are not persuasive.

a. The Applicant argues in reference to Claims 1, 3, and 12-17 that Govindarajan does not disclose "storing as a user status-setting alternative a symbol representing an advertiser, the symbol being originally provided by the advertiser and capable of reminding a person of items or services of the advertiser as well as the

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advertiser itself" (pages 8-9). The Examiner notes that this has been discussed in more detail in the rejection above. Govindarajan discloses that the icon may represent a business (such as one employing the user). A business icon (logo) is a symbol which a business has chosen to represent itself to the world, i.e. to advertise itself to the world. Hence, Govindarajan's disclosure of the user selecting a business icon as a status icon (symbol) is the equivalent of a "symbol being originally provided by the advertiser and capable of reminding a person of items or services of the advertiser as well as the advertiser itself."

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, only one reference is used, thus there is no combination of references being made. The obviousness is based on the reference's explicit disclosures and how one of ordinary skill in the art would interpret the reference's implicit teachings (e.g. business icon is an advertising symbol).

b. The Applicant provides the same argument as above in reference to Claims 2, 4, 5, 6, 7 and 8, 9-11, and new Claims 18 and 19.; thus, the same response applies. The Applicant has not disputed the previous Official Notices pertaining to the features of the Claims 4, 7, and 8. This lack of argument is viewed as implicit agreement that the features were well-known at the time of invention.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

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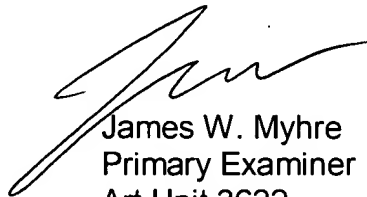
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM

October 27, 2005



James W. Myhre
Primary Examiner
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